

REMARKS

Claims 1-61 remain pending in this application. Claims 3-7, 11-13, 15-21, 29-33, 38-40, and 42-48 have been withdrawn, but may be rejoined upon allowance of a generic claim, *e.g.*, claims 1 and 26. Claims 1, 2, 8-10, 14, 22-28, 34-37, 41 and 49-61 are under examination.¹

Claim Rejections – 35 U.S.C. § 112

Claims 1, 2, 8-10, 14, 22-28, 34-37 and 49-61 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Responding to the indication in the Office Action that claim 1 is confusing, Applicant respectfully disagrees. The term “compound” is not being used in a restrictive sense, but refers to a composition of matter having the limitations as set forth in the claim. It is Applicant’s understanding that this meaning is consistent with the ordinary usage of the term in the relevant art. The Oxford Dictionary of Biochemistry and Molecular Biology, Rev. Ed., Oxford University Press (2000), for example, defines the term “compound” as “any substance containing two or more identical or nonidentical chemical atoms in fixed numerical proportions and held together by one or more kinds of chemical bond.”

¹ The Office Action Summary indicates that claim 41 has been withdrawn. Applicant has not withdrawn claim 41, and respectfully requests that the Examiner examine this claim.

Notwithstanding this, Applicant has amended the pending claims to substitute the term “composition” for the term “compound” to ensure that there is no misunderstanding or misconstruction of the latter term. These amendments are made to improve the readability of the claims, and are not intended in any way to narrow their scope. No estoppel applies.

In response to the statement in the Office Action that claims 16-21 improperly depend from claim 1 because they allegedly do not contain alkoxymethyl ether at the 17-position, Applicant again respectfully disagrees. Each of these claims expressly depend from claim 1 and thus necessarily incorporate its limitations. Moreover, each of the recited compositions expressly recites a methoxymethyl promoiety at the 17 carbon position.

As to the question in the Office Action at page 3 regarding what is intended by the term “promoiety comprising,” this refers, in standard patent law claim language format to promoieties that “comprise,” i.e., constitute or include, in open format. Thus, the promoiety may constitute the chemical group or structure specifically and expressly recited for the promoiety in the claim, or it may comprise that promoiety with one or more additional atoms, functional groups, etc., provided that the promoiety specifically called out in the claim is present.

Conclusion

In view of the foregoing, Applicant requests reconsideration of the application and passage of all pending claims to issue.

A Petition for Extension of Time and check for the extension fee are submitted concurrently herewith. If this is deficient or if there are any other fees due in connection with the prosecution of this application, please accept this as Applicant's petition for extension of time and charge the fee or deficiency to our Deposit Account No. 501324.

Dated: March 23, 2004

Respectfully submitted,



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Date of Deposit: March 23, 2004

I hereby certify that this Amendment and Response to Office Action No. 3 is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

